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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/853,291

05/11/2001

Ronald S. Lenox

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10/01/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/853,291

Applicant(s)

LENOX ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 7/17/2003. Applicant's amendments to claims 1-11, 13-39, 41 and 43-53 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.
4. Applicant's arguments with respect to claims 1-54 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

5. Claim 11 is objected to because of the following informalities:  
  
In claim 11, please add --component-- at the end of line 1, so as to be consistent with other independent claims, and also clarify the claimed subject matter.  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. Claims 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the newly amended independent claims 1, 11, 22, 30, 43, 52 now recites in part "melt-processed layer comprising a strength-imparting non-PVC polymer and about 55% to about 80% by weight filler". The Examiner notes that the phrase "by weight filler" is vague, indefinite and confusing, i.e., it is unclear what is the basis weight. For the purpose of this Office action, it is presumed to be the weight of the melt-processed layer.

Similarly, the weight basis in claims 3, 7, 14, 17, 24, 27, 33, 36, 44, 45, 48 also need to be clarified. For the purpose of this Office action, it is presumed that for claims 3, 14, 24, 33, 44 and 48, the weight basis is presumed to be the weight of the melt-processed layer. For claims 7, 17, 27, 26 and 45, the weight basis is presumed to be the polymer blend.

Finally, in independent claims 1, 11, 22, 30, 43, 52, the phrase "the same thickness, filler type and percent filler content ..." in newly amended recitations appears vague and indefinite, i.e., it is unclear what is the exact scope of the term "same".

#### ***Response to Amendment***

7. Claims 1-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission either taken individually, or in view of DD 88659A (Derwent Abstract).

The Examiner repeats (see section 4 of Paper No. 5) that it appears that Applicants have admitted that multi-layered polymeric sheets have been widely used as resilient surface coverings, especially to cover floors. Some multi-layer resilient surface

coverings include melt-processed base layers formed of resins composed of polyvinyl chloride (PVC) homopolymer, which provide strength and durability to the surface covering sheet (Specification, page 1, lines 16-21).

For claims 1-54, it is believed that blending PVC with a compatible elastomer, such as nitrile rubber, and a large amount of filler is old and conventional, so as to improve the impact and abrasion resistance, and/or to reduce the cost. Alternatively, it is noted that DD '659 is directed to a floor covering with suitable elasticity despite a high filler content. The floor covering comprises a mixture of (%wt) 13-22 PVC, 14-17 butadiene/acrylonitrile copolymer (i.e., nitrile rubber), 50-57 oil shale, and 8-14 other processing aids (Derwent Abstract). As such, it would have been obvious to one of ordinary skill in the art to modify the PVC homopolymer layer of the admitted prior art with the highly filled elastic PVC blend of DD '659, motivated by the desire to improve the elastic property of the floor covering.

As to the product-by-process recitations in independent claims 1, 11, 22, 30, 43, 52, it should be pointed out that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300

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*Daniel Zinker*